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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,797	02/03/2004	Andrew Shun Pui Chiu	016660-193	9241

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BUCHANAN INGERSOLL PC
(INCLUDING BURNS, DOANE, SWECKER & MATHIS)
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EXAMINER	
MILLER, BENA B	
ART UNIT	**PAPER NUMBER**
3725	

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/769,797	CHIU, ANDREW SHUN PUI	
	Examiner	Art Unit	
	Bena Miller	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-6 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-6 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Bena B. Miller

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 are finally rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter, "whereby physical effort is exerted by the user to directly generate electrical power", as now amended, is not supported by the original specification and therefore, now constitute New Matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is not clear whether physical effort, exerted by the user, is directly generate electrical power to the slot of the toy. It should be noted that the specification of the claimed invention discloses the on page 4, par. 5 that "when a user steps on the pedal, the belt roller attached to the pedal rotates with the belt which thus drives the rotating shaft of the motor. The motor supplies power to the electric sound

effect unit and track via the power cord". Therefore, it is not clear how the electrical power is directly generated to the slot of the toy by the physical effort of the user.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Smack in view of Seelig, as set forth in previous Office Action.

Smack, Sr. et al teaches in the figures most of the elements of the claimed invention including a hand-operated, foot-operated , treadmill-operated generator means (col. 5, lines 60-65; it should be noted the Examiner considers the illusion of running by the user's feet meets the limitation of the treadmill-operated generator) and "whereby physical effort is exerted by the user to directly generate electrical power" (col. 5, line 60 – col. 6, par. 1; The user uses his/her foot to exert electrical power directly (note, as best understood, per 35 USC 112 1st and 2nd rejections, noted above), to the slot through the switches 38 and 40 interacting with drive generator 66, line 28 and jack 42) . However, Smack, Sr. et al fails to teach at least one toy car and a sound generating means. It should be noted that it is well known in the prior art to provide a toy with sound. Therefore, it would have been obvious to one having ordinary skill at the time the invention was made to incorporate sound in the toy of Smack, Sr. et al for

the purpose of providing amusement to the toy. Further, Seelig et al teaches a slot machine and racing game having a car advance along a track (Abstract, lines 1-8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a car as taught by Seelig et al for the toy of Smack, Sr. et al for the purpose of providing amusement to toy.

Claims 1-6 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bliss in view of Seelig, as set forth in previous Office Action.

Bliss teaches in the figures most of the elements of the claimed invention including foot-operated (col. 1, line 63- col. 2, line 5) and "whereby physical effort is exerted by the user to directly generate electrical power" (col. 3, par. 3; The usser uses his/her foot to exert electrical power directly (note, as best understood, per 35 USC 112 1st and 2nd rejections, noted above), to the slot by jogging on mat 32 wherein the mat causes the multivibrator 112 to pass a pulse to pulse counter 114 so that motor 50 is driven by switching circuit 110. However, Bliss fails to teach at least one toy car and a sound generating means. It should be noted that it is well known in the prior art to provide a toy with sound. Therefore, it would have been obvious to one having ordinary skill at the time the invention was made to incorporate sound in the toy of Bliss for the purpose of providing amusement to the toy. Further, Seelig et al teaches a slot machine and racing game having a car advance along a track (Abstract, lines 1-8). It would have been obvious to one having ordinary skill in the art at the time the invention

was made to use a car as taught by Seelig et al for the toy of Bliss for the purpose of providing amusement to toy.

Response to Arguments

In response to Applicant's arguments, Applicant's attention is directed above.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 571.272.4427. The examiner can normally be reached on Monday-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Bena Miller
Primary Examiner
Art Unit 3725

bbm
May 26, 2006